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UNITED STATES PATENT AND TRADEMARK OFFICE U.S. PATENT & TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re) Decision on Petition
) under 37 CFR § 10.2(c)
)

This is a decision on a petition filed April 23, 1990,
by (petitioner) under 37 CFR § 10.2(c).
Petitioner requests review of the decision of the Director of
Enrollment and Discipline, entered March 26, 1990, refusing to
register petitioner to practice before the Patent and Trademark
Office.

The Director's decision was on a request for regrade of question 2 of the afternoon section of the examination for registration held on October 11, 1989. The Director refused to add any points to petitioner's score of 61 on the afternoon section. A score of 70 (out of 100) is required for a passing grade.

BACKGROUND

Petitioner's ground for challenging his score on the afternoon section of the examination is that his answer to question 2 is correct. Question 2 is a 4-part question, each part worth 10 points for a total of 40 points. Petitioner was credited with only 13 points for the question. Petitioner requests full credit of 40 points.

FACTUAL REVIEW

Question 2 sets forth a fact situation concerning an invention and patent application containing, as original

claims, independent claim 1, claim 2 dependent therefrom, and claim 3 dependent from claim 2. The patent application has a disclosure of only one embodiment, which is the identical embodiment to that of claim 3. On July 2, 1989, or subsequent to preparation of the patent application but before the application was filed, the inventor discovered another embodiment of the invention that worked best (later-discovered embodiment). The patent application was then filed on July 17, 1989, but without a description of the best-mode embodiment. Question 2 poses various questions concerning strategies to be followed or steps to be taken on or after October 1, 1989, by a registered patent practitioner in order to protect the business interests of his client seeking to buy the inventor's rights to the invention and patent application.

Question 2A

This question asks whether or not the following strategy (Strategy I) is suitable to protect the business interests of the client, and why:

Make no amendment to the application itself, but file "Remarks" which explain the superiority of the [later-discovered] embodiment and which fully describe the best mode and how to make and use the embodiment

Petitioner correctly answered "No" that Strategy I would not protect the business interests of the client. Petitioner explained that the filing of a "Remarks" section has no bearing on the claims or disclosure of the application "in this case." Petitioner then stated that the specification does not support

the claimed subject matter, that the specification does not support generic claim 1, and that only claim 3 can possibly be allowed. Petitioner stated further that since the strategy did not present a claim to the later-discovered embodiment, the embodiment would never be examined.

The grader deducted 5 points from petitioner's answer to this 10-point question for its failure to show any recognition that the "best mode" requirement of 35 U.S.C. § 112 was not satisfied in the patent application and that this was a fatal defect to the issuance of claims in the application. The grader also pointed out that contrary to petitioner's answer, the claims do encompass the later-discovered embodiment and that since the claims are original claims, they are part of the disclosure. The grader added that only the best mode for claim 3 was disclosed.

Petitioner argued before the Director that while the "best mode" reason was correct, the reason given in his answer was also correct. Petitioner disagreed that the claims encompassed the later-discovered embodiment.

Question 2B

This question asks whether or not the following strategy (Strategy II) is suitable to protect the business interests of the client, and why:

File an amendment to the specification adding the following paragraph:

"In accordance with a preferred embodiment,
[description of later-discovered embodiment].

Petitioner correctly answered "No" that Strategy II would not protect the business interests of the client. Petitioner explained that this strategy adds new matter to the specification and that for this reason would be "denied" by the Office. Petitioner noted that no claim to the later-discovered embodiment was presented, adding that it would be rejected because it is "out of scope of the specification." Petitioner also repeated part of his answer to question 2A, in which he stated that the claims "as they stand" in the application are not allowable because they are broader than the specification. Finally, petitioner commented that there was no oath or declaration filed with the amendment.

The grader deducted four points from petitioner's answer to this 10-point question. Two points were deducted for failing to recognize that the amendment would not correct the "best mode" defect. Two points were also deducted for the incorrect reasoning that the existing claims were not allowable because they were broader than the specification.

Petitioner argued before the Director that Strategy II was unsuitable for three reasons. These are (1) failure to cure the "best mode" problem, (2) introduction of "new matter" and (3) generic claim 1 would continue to be unsupported by the specification. Petitioner argues that the two reasons which he raised in his answer ((2) and (3)) are correct.

Question 2C

This question asks whether or not, and to explain why, it would be better than either Strategy I or II to file a further, completely new patent application otherwise identical to the existing patent application, except that it would include a description in the specification of the later-discovered embodiment and how to make and use it.

Petitioner incorrectly answered "No" that it would not be better, essentially repeating the statements made in his answers to questions 2A and B that claim 1 would still not be supported by the specification. Petitioner also stated that there is no claim for covering "the invention," presumably meaning no claim for the later-discovered embodiment.

The grader deducted 10 points from petitioner's answer to this 10-point question for failing to recognize that the new application is the best strategy to correct the "best mode" defect. The grader also pointed out, again, that original claims are part of the original disclosure.

Petitioner argued before the Director that his answer was correct, relying on his earlier discussion with regard to his answer to question 2A that claim 1 is not supported by the specification and would be rejected.

Question 2D

This question assumes that an article in a Canadian publication disclosing the later-discovered embodiment is published on July 15, 1989. The question then asks whether or

not there would be any benefit in designating the new application, as discussed in question 2C, a continuation-in-part (C-I-P) of the original application, and why.

Petitioner correctly answered "No" that there would be no benefit. As the reason, petitioner explained that a C-I-P application is entitled to the date of a parent application only for matter described in the specification of the parent application, and that since the generic claim 1 and the later-discovered embodiment were not described in the parent application, there would be no advantage to filing a C-I-P. Petitioner additionally stated that there was no prior art which would constitute a statutory bar against the "application." According to petitioner, the [original] invention was made in 1988 and the publication date in Canada is 1989, which means that the invention is prior to any statutory bar. The first use by the inventor of his "own invention" was also July 1989, which is not a statutory bar for an application to be filed in October 1989. Therefore, there is no benefit in filing a C-I-P application.

The grader deducted 8 points from petitioner's answer to this 10-point question for failing to recognize that the "best mode" defect in the parent application is fatal to priority for any subsequent application. The grader also pointed out that the Canadian publication is a "102(a) bar until [a Rule] 131 [affidavit is] filed," meaning that the Canadian publication is a reference under 35 U.S.C. § 102(a) since its publication date

is two days before the filing date of the original application, which reference may be removed only by a showing under 37 CFR § 1.131 of invention before the publication date.

Petitioner argued before the Director that his answer to this question was correct, again relying on his previous argument that generic claim 1 was not supported by the specification of the original application.

DECISION

The Director treated petitioner's arguments concerning questions 2A, 2B, 2C and 2D together. He refused to add any points to petitioner's score on this question, pointing out that original claims are part of the original disclosure and that claim 1 is of sufficient breadth to encompass the later-discovered embodiment. The Director also pointed out that petitioner provided no reasons for his disagreement with the grader's comment that the claims encompass the later-discovered embodiment.

In his petition for review under 37 CFR § 10.2(c), petitioner continues to argue that claim 1 has no support in the specification and then argues that this claim must be rejected as indefinite under 35 U.S.C. § 112. Petitioner argues that the fact pattern shows a violation of 37 CFR § 1.75(d)(1) and that this rule "conflict[s]" with MPEP 608.01(1).

While the fact pattern may show a "violation" of 37 CFR § 1.75(d)(1), it has no effect on claim 1, an original claim,

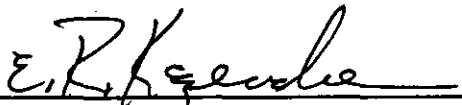
as MPEP 608.01(1) makes clear. A requirement to amend the specification to conform to the original claims would have been proper under § 1.75(d)(1). The status of the original claims, however, would remain the same--they would still be part of the original disclosure.

Petitioner failed completely in the examination to appreciate the "best mode" issues, which permeated all parts to question 2, while failing to realize that original claims are entitled to the filing date of the application in which they appear, even if they do not conform to the invention set forth in the remainder of the specification. As indicated in the model answers to question 2, the first application did not meet the requirements of 35 U.S.C. § 112, ¶ 1, because it did not disclose the best mode. Thus, no valid patent could issue on that application. As further indicated in the model answers, refiling is the only way the invention and the interest of the client could be protected.

A thorough and detailed review of the entire record indicates that the Director was correct in refusing to award petitioner any points on his request for a regrade of question 2.

CONCLUSION

The Director's decision of March 26, 1990, is affirmed.
Therefore, this petition is denied.


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Commissioner of Patents
and Trademarks